

### **REMARKS**

The undersigned first wishes to thank Examiner Kam for entering the amendment after final and for the telephone interview of February 22, 2005. The amendment presented here will not require any further search and does not introduce any issue of new matter. Therefore, entry of this amendment is respectfully requested.

Claims 1-2, 4-11, 13-17, 19, 23-44 and 52-55 were pending in the subject application. Applicants have amended the claims as follows:

- (i) amended claims 8, 9, 10 and 16 to correct the spelling of the term "exogeneously" as requested by the Examiner in the above-referenced telephone interview, Applicants have;
- (ii) amended claims 34 and 35 to provide proper antecedent basis as requested by the Examiner;
- (iii) amended claim 1 to recite the elements of objected claim 43, since the Examiner indicated that claim 43 would be allowable if rewritten to recite all the elements of the base claim; and
- (iv) canceled claim 43, since the elements of claim 43 have been incorporated into claim 1.

This amendment does not involve any issue of new matter. Applicants respectfully request entry of this amendment such that claims 1-2, 4-11, 13-17, 19, 23-42, 44 and 52-55 will be pending.

### **Withdrawal or Previous Rejections**

Applicants acknowledge that the Examiner has withdrawn all previous rejections in the Advisory Action except for the rejection of claims 1, 11, 14, 23, 38, 40, 41 and 44 under 35 USC 103(a) as allegedly unpatentable over Rothschild et al. (U.S. Patent 5,643,772).

### **Claim Objections**

The Examiner objects to claim 34 and 35 under 35 USC § 112, 2nd paragraph as being allegedly indefinite for lacking sufficient antecedent basis for the term "one or more of each codon." In response, Applicants have amended claims 34 and 35 to replace this term with the phrase "exogenous elongator amino acyl tRNA species" to provide proper antecedent basis. Applicants respectfully request withdrawal of this ground of rejection.

Claim Rejections 35 USC §103

The Examiner maintains her rejection of claims 1, 11, 14, 23, 38, 40, 41 and 44 as allegedly obvious by Rothschild et al. (U.S. Patent 5,643,722, July 1, 1997). The Examiner concedes that "Rothschild does not specifically indicate the translation system has highly selective incorporation at each codon," but alleges that since Rothschild suggests the use of purified translation factors, such system "translates mRNA with a highly selective incorporation at each codon."

Applicant's again traverse the Examiner's rejection. MPEP 2121.01 requires that a reference be enabling in order to anticipate a claimed invention:

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). \*>The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference enabled one of ordinary skill in the art to produce Elan's claimed transgenic mouse without undue experimentation. Without a disclosure enabling one skilled in the art to produce a transgenic mouse without undue experimentation, the reference would not be applicable as prior art.).< A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Applicants submit that Rothschild does not provide an enabling disclosure for making a translation system capable of producing peptidomimetics with highly selective incorporation at each codon. At most, Rothschild invites one skilled in the art to engage in excessive and undue experimentation to determine the combinations of purified translation factors and reaction conditions necessary to achieve highly selective incorporation.

Nevertheless, without conceding the correctness of the Examiner's rejection but merely to expedite the allowance of the claims, applicants have amended claim 1 to recite the elements of claim 43, since the Examiner has conceded that claim 43 would be allowable if rewritten in

independent form including all the elements of the base claims and any intervening claims. Accordingly, applicants deem amended claim 1 to be in condition for allowance. Furthermore, since all other claims which were rejected or objected to depend on claim 1, all claims are deemed allowable. Applicants request reconsideration and withdrawal of this ground of rejection.

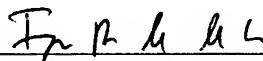
### **CONCLUSIONS**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. Applicants note that if this amendment does not place the claims in condition for allowance, it does place the claims in better condition for appeal according to MPEP 714.13 (III). Accordingly, applicant respectfully requests that this amendment be entered.

Applicant believes that no fee is due at this time in addition to the \$520 fee for a three-month extension of time and the \$240 fee for the Notice of Appeal. However, if any additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. AFOR-P01-001 from which the undersigned is authorized to draw.

Dated: March 22, 2005

Respectfully submitted,

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